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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/788,732

02/27/2004

Lee D. Saathoff

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EXAMINER

GOLOBOY, JAMES C

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/09/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/788,732	Applicant(s) SAATHOFF ET AL.	
	Examiner James Goloboy	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>7/28/08 & 10/6/08</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendments filed 7/28/08 overcome the rejections under 35 USC 112 set forth in the previous office actions. The rejections under 35 USC 102 and 103 are maintained below.

Continued Examination Under 37 CFR 1.114

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7/28/08 has been entered.

Claim Rejections - 35 USC § 102/103

3. Claims 1-3, 5-9, and 11-12 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Izumi (U.S. Pat. No. 3,720,615).

This rejection of the claims as anticipated by Izumi is adequately set forth in paragraph 5 of the office action mailed 9/24/07, which is incorporated here by reference.

Claim Rejections - 35 USC § 103

4. Claims 1-4, 6-7, and 9-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe (U.S. Pat. No. 4,177,153).

The rejection is adequately set forth in paragraph 6 of the office action mailed 9/24/07.

5. Claims 13, 15-16, and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Ohtani (U.S. Pat. No. 5,344,579).

The rejection is adequately set forth in paragraph 7 of the office action mailed 9/24/07.

6. Claims 14, 17, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Watts (U.S. Pat. No. 6,225,266).

The rejection is adequately set forth in paragraph 8 of the office action mailed 9/24/07.

7. Claims 20-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay (U.S. Pat. No. 4,795,583) and Field (U.S. Pat. No. 6,844,301).

The rejection is adequately set forth in paragraph 9 of the office action mailed 9/24/07.

Art Unit: 1797

8. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claim 20 above, and further in view of Ohtani.

The rejection is adequately set forth in paragraph 10 of the office action mailed 9/24/07.

9. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Lowe in view of Papay and Field as applied to claim 20 above, and further in view of Watts.

The rejection is adequately set forth in paragraph 11 of the office action mailed 9/24/07.

Response to Arguments

10. Applicant argues that “power transmission fluid” is a claim limitation rather than an intended use, and that power transmission fluids contain particular additives in particular proportions that are not desirable in other types of lubricating fluids, implying that the prior art compositions cited in the previous office actions are not sufficient as power transmission fluids. However, as discussed in paragraph 8 of the office action mailed 4/5/07, applicant clearly defines numerous additives as optional in power transmission fluids (page 13 of the specification), and has not shown which non-optional additives are absent in the prior art compositions, nor has applicant shown which additives present in the prior art compositions must be excluded from power transmission fluids.

Art Unit: 1797

Applicant's arguments regarding Lowe have been discussed in paragraph 8 of the office action mailed 4/5/07, and the examiner maintains the positions set forth in that office action. Applicant further argues that Lowe is not properly combined with Watts because the composition of Lowe preferably comprises a zinc salt, while Watts discloses a zinc-free composition. While the zinc salt of Lowe is a preferred component, it is not a required components of the lubricating composition. It therefore would have been within the scope of ordinary skill in the art to exclude the zinc salt from the composition of Lowe when used in a continuously variable transmission, as taught by Watts.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James Goloboy whose telephone number is (571)272-2476. The examiner can normally be reached on M-F 9-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1797

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JCG

/Glenn A Caldarola/
Acting SPE of Art Unit 1797